

REMARKS

Claims 1, 4-15, and 43-53 are pending in this application. These claims stand rejected under 35 U.S.C. § 102(b) and § 102(f). Applicants thank Examiner Weitach for the interview granted November 3, 2005 at which this rejection was discussed and submit the present remarks consistent with that interview.

Rejection under 35 U.S.C. § 102(b)

Claims 1, 4-15, and 43-53 stand rejected under 35 U.S.C. § 102(b) over University of Massachusetts Uniform Invention Disclosure Form dated 11/23/98. The Office states that there "is no indication on the form as to its confidentiality..., and it is assumed that it was publicly available prior to the priority date of the instant application." This rejection is respectfully traversed. As indicated by the Office, to qualify as prior art under 35 U.S.C. § 102(b), subject matter must be described in a printed publication in this or a foreign country more than one year prior to the date of application for patent in the United States. The cited document, University of Massachusetts Uniform Invention Disclosure Form dated 11/23/98, does not qualify as prior art under 35 U.S.C. § 102(b). Under University of Massachusetts policy, this document would have been maintained as confidential as of one year prior to Applicants' filing date of December 21, 2001 and therefore does not constitute a printed publication. This rejection may be withdrawn.

Rejection under 35 U.S.C. § 102(f)

Claims 1, 4-15, and 43-53 stand further rejected under 35 U.S.C. § 102(f) on the basis that the presently named inventors did not invent the subject matter of these claims. The Office states that the University of Massachusetts Uniform Invention Disclosure Form dated 11/23/98 indicates a single inventor, James M. Robl, while the present application names the additional inventors, Philippe Collas, Eddie Sullivan, and P.

Kasinathan, and further that the Invention Disclosure Form "discloses and discusses" the present invention. This rejection is also respectfully traversed.

The University of Massachusetts Uniform Invention Disclosure Form of 11/23/98 describes "the use of a somatic cell cytoplasm for reprogramming the function of a nucleus from a different cell" for the purpose of "transplantation into patients for the treatment of disease." As earlier indicated by Applicants during the Patent Office interview of November 3, 2005, this rejection should be withdrawn because the presently claimed method differs significantly, both in substance and purpose, from the subject matter discussed in that Invention Disclosure Form.

Specifically, the presently claimed method involves four steps, none of which is described by the University of Massachusetts document. As a first step, the presently claimed method involves *permeabilizing* a mammalian cell to facilitate contact between the cell's genetic material and a reprogramming extract. This step is not utilized in the technique of the Invention Disclosure Form. In the second step of the presently claimed method, the permeabilized cell is incubated in a *mitotic extract* for reprogramming. The method of the Invention Disclosure Form, in contrast, makes use of traditional nuclear transfer techniques for reprogramming in which the nucleus from a first cell is physically moved into a second cell, in this case, the somatic cell cytoplasm, a cell structure that includes a cell membrane; no extract is utilized. In the third and fourth steps, the presently claimed technique requires "*inserting* said cell formed in step (b) [the permeabilized cell following mitotic cell extract incubation] *into* a nucleated or enucleated *oocyte*, thereby forming a reconstituted oocyte" and "*transferring* said reconstituted oocyte or an embryo formed from said reconstituted oocyte *into* the uterus of a *host mammal* under conditions that allow said reconstituted oocyte or said embryo to develop into a fetus." These steps of oocyte and embryo transfer also appear nowhere in the Invention Disclosure Form.

Consistent with these differences in method steps, the purpose of the presently claimed technique also differs entirely from that of the cited Invention Disclosure Form. The presently claimed technique is a "method of cloning a non-human mammal," while the Invention Disclosure Form discusses a method for changing the function of a cell for the purpose of "transplantation into patients for the treatment of disease."

Thus, the subject matter of the University of Massachusetts Uniform Invention Disclosure Form dated 11/23/98 differs substantially from the method presently claimed and fails to provide a basis for the assertion that the named Applicants did not invent the currently claimed subject matter. The rejection under 35 U.S.C. § 102(f) should also be withdrawn.

Rejection Based on Double Patenting

Claims 1, 4-15, and 43-53 also stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of copending applications, Robl (2004/0068760) and Collas (2002/0142397). As the claims of these copending applications have not yet been allowed or issued, Applicants request withdrawal of this rejection upon an indication of otherwise allowable subject matter in the present case, as required by MPEP 822.

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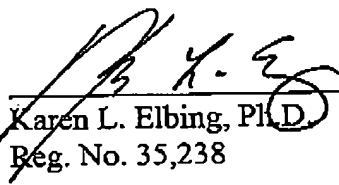
CONCLUSION

Applicants submit that this case is now in condition for allowance, and such action is respectfully requested.

If there are any additional charges or any credits, please apply them to Deposit Account No. 03-2095.

Respectfully submitted,

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